

This Opinion is Not a  
Precedent of the TTAB

Mailed: January 18, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re RAI Strategic Holdings, Inc.*  
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Serial Nos. 88662587  
88822603<sup>1</sup>  
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for RAI Strategic Holdings, Inc.

Michael FitzSimons, Trademark Examining Attorney, Law Office 103,  
Stacy Wahlberg, Managing Attorney.

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Before Kuhlke, Wolfson and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

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<sup>1</sup> Upon Applicant's request, the Board consolidated the appeals on July 14, 2022. 11 TTABVUE. Citations to TTABVUE throughout the decision are to the Board's public online database that contains the appeal file, available on the USPTO website, [www.USPTO.gov](http://www.USPTO.gov). The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s).

Citations to the examination record refer to the USPTO's online Trademark Status and Document Retrieval system (TSDR). Unless otherwise indicated, citations are to the TSDR and TTABVUE records in Application Serial No. 88662587.

RAI Strategic Holdings, Inc. (“Applicant”) seeks registration on the Principal Register for the mark VUSE CHARGE BEYOND in standard characters for goods and services ultimately identified as:

Retail store services connected with the sale of e-cigarettes, electronic cigarettes, liquid solutions for use in electronic cigarettes, tobacco, tobacco substitutes not for medical purposes, smokers' articles, matches, personal vaporisers and electronic cigarettes and flavourings and solutions therefor, tobacco products for the purpose of being heated, devices and parts for devices for heating tobacco and tobacco substitutes for the purpose of inhalation, snus with tobacco, snuff with tobacco, snus without tobacco, snuff without tobacco, tobacco free oral nicotine pouches not for medical purposes, chargers, jewellery, horological instruments, stationery, cases, sleeves, pouches, clothing, footwear and headwear, in International Class 35;<sup>2</sup>

Cigarettes, namely, electronic cigarettes; electronic cigarette components, namely, cartridges and replacement cartridges filled with liquid nicotine solutions, namely, chemical flavorings for use in electronic cigarettes and other vapor devices in the nature of electronic cigarettes; liquid nicotine solutions for use with electronic cigarettes and other vapor devices in the nature of electronic cigarettes; liquid nicotine solutions featuring flavorings for use with electronic cigarettes and other vapor devices in the nature of electronic cigarettes; holders for electronic cigarettes; holders for cigarettes; boxes for electronic cigarettes; boxes for cigarettes; smokers' articles for electronic cigarettes, namely, protective cases and carrying cases for electronic cigarettes, fitted cases of leather or imitation leather for electronic cigarette accessories in the nature of protective cases, carrying cases, decorative wraps for device, and sleeves and pouches for electronic smoking

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<sup>2</sup> Application Serial No. 88662587, filed on October 21, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of its intent to use the mark in commerce.

devices; smokers' articles for electronic cigarettes being protective cases, in International Class 34.<sup>3</sup>

The Trademark Examining Attorney refused registration of Applicant's mark in each application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified goods and services, so resembles the registered mark BEYOND<sup>4</sup> in standard characters for:

Chemical flavorings in liquid form used to refill electronic cigarette cartridges, in International Class 30;

Electronic cigarette refill cartridges sold empty; electronic cigarettes; electronic cigarette starter kits primarily comprised of electronic cigarettes, electronic cigarette refill cartridges sold empty and an electronic cigarette case and also featuring electronic cigarette batteries, USB battery chargers and an adapter, in International Class 34;

Retail store services featuring electronic cigarette vaporizers, portable electronic cigarette vaporizers, accessories for electronic cigarette vaporizers, electronic cigarettes, electronic cigarette starter kits, hand-operated electronic cigarette atomizers, chemical flavorings in liquid form used to refill hand-operated electronic cigarette atomizers, electronic cigarette vaporizers and electronic cigarettes, electronic cigarette batteries, battery chargers for electronic cigarette batteries, USB chargers for electronic cigarette batteries and car chargers for electronic cigarette batteries; on-line retail store services featuring electronic cigarette vaporizers, portable electronic cigarette vaporizers, accessories for electronic cigarette vaporizers, electronic cigarettes, electronic cigarette starter kits, hand-operated electronic cigarette atomizers, chemical flavorings in liquid form used to refill hand-operated electronic cigarette atomizers, electronic cigarette vaporizers and electronic cigarettes, electronic

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<sup>3</sup> Application No. 88822603 filed March 5, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of its intent to use the mark in commerce.

<sup>4</sup> Registration No. 4737825, issued on May 19, 2015, partial Section 8 & 15 accepted and acknowledged. The Section 8 filing deleted International Classes 9 and 41.

cigarette batteries, battery chargers for electronic cigarette batteries, USB chargers for electronic cigarette batteries and car chargers for electronic cigarette batteries, in International Class 35

as to be likely to cause confusion. In addition, the Examining Attorney required a disclaimer of the word CHARGE in both applications.

When the refusals were made final, Applicant appealed and requested reconsideration in each application. After the Examining Attorney denied the requests, the appeals resumed and briefs were filed. We affirm the refusals to register.

#### I. Disclaimer Requirement

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. 15 U.S.C. § 1056. *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015). In the absence of acquired distinctiveness, merely descriptive terms are unregistrable under Section 2(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *La. Fish Fry*, 116 USPQ2d at 1264 (citing *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005)) (“The PTO can condition the registration of a larger mark on an applicant’s disclaimer of an ‘unregistrable component of a mark otherwise registrable.’ 15 U.S.C. § 1056(a)”). *See also In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information of a quality, feature, function,

or characteristic of the goods or services in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). By contrast, a term is suggestive if it “requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods.” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). The determination of whether a term is merely descriptive must be made “in relation to the goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)).

The word CHARGE is defined as “to give an electric charge to”<sup>5</sup> and “to cause formation of a net electric charge on or in (a conductor, for example)” and “to energize (a storage battery) by passing current through it in the direction opposite to discharge.”<sup>6</sup> The Examining Attorney argues that the word CHARGE is merely descriptive of a characteristic of “applicant’s services because the goods featured in applicant’s retail store services include rechargeable electronic cigarettes and ‘chargers’” (Ex. Att. Brief, 12 TTABVUE 5) and “applicant’s goods because they include rechargeable electronic cigarettes that require an electric charge to operate”

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<sup>5</sup> <https://www.merriam-webster.com>, January 20, 2020 Office Action, TSDR p. 20.

<sup>6</sup> <https://www.ahdictionary.com>, App. Ser. No. 88822603 June 3, 2020 Office Action, TSDR p. 14.

(App. Ser. No. 88822603, Ex. Att. Brief, 9 TTABVUE 6). In addition to the dictionary definitions, the Examining Attorney relies on excerpts from web pages showing that “the goods featured in applicant’s retail store services require an electric charge to operate”(Ex. Att. Brief, 12 TTABVUE 5) and “the electronic cigarettes identified in the application require an electric charge to operate” (App. Ser. No. 88822603, Ex. Att. Brief, 9 TTABVUE 6). Representative samples showing consumer exposure to descriptions of how electronic cigarettes are charged are reproduced below:

## A Guide to Safe E-Cig Charging

By Lindsay Fox Posted March 24, 2014

Like 1



Like all lithium batteries, e-cigarettes have the potential to fail, and this often occurs when charging.

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<sup>7</sup> <https://ecigaretterevuewed.com>, January 20, 2020 Office Action, TSDR p. 21.

How does an electronic cigarette work? That's a question that lots of people don't seem to have a good answer to – and many of them, including scientists and journalists, really should know better. Luckily it's not all that difficult to explain.

Electronic cigarettes are also called vapes, and that gives a big clue to how they work. The big white cloud they create isn't smoke; it's an aerosol made up of vapour and tiny droplets of liquid. All the electronics and other components inside an e-cig are there to create this aerosol out of the liquid in the tank.

Every e-cigarette has three main components: The battery, the tank and the atomiser. All of these come in a huge variety of types and sizes, and quite often you'll see two or even all three combined into a single unit. However the device is put together, though, it will definitely have all three – otherwise it wouldn't work. Here's what they do.

## The battery

An e-cigarette's battery provides the electricity that powers the whole thing.

Almost all e-cigs use lithium ion or lithium polymer batteries, because these can pack a lot of energy into a small space; vapes drain a lot more current than most portable electronics, so they need good batteries.

All smaller vapes – the ones that look like traditional cigarettes, plus the more popular pen-style models – have a built-in battery. This means that when the battery wears out (usually after about 300 **charge** cycles) you have to throw the whole device away and replace it.

Some larger e-cigs – the devices called "mods" – also have built-in batteries. These batteries tend to be bigger and store a lot more power, so they'll usually outlive the rest of the device. By the time the battery has been through enough cycles that it won't hold a decent **charge** anymore, something else – usually one of the buttons – has worn out.

Finally, most mods use removable batteries. These come in several sizes but almost all modern devices use the 18650 size. Removable batteries have several advantages. The obvious one is that if the batteries go flat, you can just change them and keep using the mod. This lets you quickly **recharge** the flat ones in a standalone **charger**.

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<sup>8</sup> <https://vapingpost.com>, App. Ser. No. 88822603, June 3, 2020 Office Action, TSDR p. 17-20.

Applicant traverses the refusal arguing that CHARGE is part of the unitary phrase CHARGE BEYOND and should not be disclaimed. Specifically, Applicant argues that:

[C]onsumers who encounter Applicant's Mark as a whole will view and perceive Applicant's Mark. Applicant's Mark is VUSE CHARGE BEYOND. The mark is comprised of Applicant's well-known VUSE house mark together with the phrase "charge beyond." If Applicant's Mark were, for example, VUSE CHARGE, the descriptive significance of the single word "charge" might cause people to immediately understand a reference to the nature of the goods sold through Applicant's Services. However, here, the words "charge *beyond*" function as a unit, relating to one another rather than directly to Applicant's Services. In addition, the word "charge" is subject to multiple meanings such that when the word is combined into the phrase "charge beyond" Applicant's Mark suggests something more than merely describing an electrical component of goods sold through Applicant's Services.

In addition to the definition of "charge" that refers to battery or electrical power, "charge" has the following additional meanings that are more relevant to how consumers will perceive and understand the phrase "charge beyond" in Applicant's mark:

1. To pervade or fill, as with a feeling or quality;
2. A feeling of pleasant excitement; a thrill; and
3. To move quickly or forcefully;

...

Taking into consideration Applicant's Services, along with the above additional meanings of the word "charge," and further considering its use in the phrase "charge beyond," Applicant's Mark has multiple potential connotations to consumers. For example, it may connote that Applicant's brand evokes a certain feeling or emotion in users that may surpass (i.e., be beyond) their expectations. Likewise, it may connote that Applicant, the distributor of the VUSE

brand of products offered through Applicant's Services, is forcefully moving forward the technology and consumer experience associated with Applicant's products and services, which are part of a growing industry of alternative smoking and nicotine devices and accessories, and it is moving that experience forward and "beyond" what is traditionally expected from these types of products and services. The exact meaning of the phrase "charge beyond" in Applicant's Mark may not even be known by consumers perceiving the mark. Rather, consumers will use imagination, thought and perception to determine how the words "charge beyond" refer to Applicant's Services and brand experience.

App. Brief, 9 TTABVUE 10-11.

In support of its arguments, Applicant submitted several third-party registrations for marks that include the word CHARGE without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), or a disclaimer.

A portion of a mark that contains more than one term is considered to be a unitary component of an entire mark when the portion creates a commercial impression separate and apart from any unregistrable component forming the portion, or from the mark as a whole. The test for unitariness inquires whether the elements are so integrated or merged together that they cannot be regarded as separable. *See In re EBS Data Processing*, 212 USPQ 964, 966 (TTAB 1981); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). The Court of Appeals for the Federal Circuit has set forth the elements of a unitary mark:

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In

other words, a unitary mark must create a single and distinct commercial impression.

*Dena Corp.*, 950 F.2d at 1561, 21 USPQ2d at 1052. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise, is required.

We begin by observing that only one of the fifteen third-party registrations for similar goods or services Applicant submitted, supports its position that CHARGE should not be disclaimed.<sup>9</sup> As the Examining Attorney explained, the twelve examples where the words are telescoped, compounded or hyphenated are not subject to disclaimer requirements. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1213.05(a) and cases cited therein. Two examples are clearly part of an actual phrase in speech, LEADING THE CHARGE and CATCH A CHARGE. This leaves one example, FITBIT CHARGE, to support Applicant's position. By contrast, the Examining Attorney submitted ten third-party registrations for electrically powered goods or services where none of the exceptions (e.g., words are compounded, telescoped or hyphenated) were present and the word CHARGE is disclaimed.<sup>10</sup> The third-party registration evidence of record tends to undermine Applicant's position.

Turning to Applicant's proposed alternative meanings, we agree with the Examining Attorney that "the relationship between the word 'CHARGE' and the word 'BEYOND' is not readily apparent," and "[c]onsumers would not likely look past the merely descriptive significance of the term 'CHARGE' in applicant's VUSE CHARGE

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<sup>9</sup> See February 24, 2021 Office Action pp. 18-35.

<sup>10</sup> See March 22, 2021 Reconsideration Letter, TSDR pp. 2-25.

BEYOND mark to view the term as meaning that applicant is forcefully advancing technology or to evoke emotions beyond their expectations.” Ex. Att. Brief, 12 TTABVUE 6, 9.

Other than its claim of ownership of prior registrations, there is no evidence to support VUSE as a well-known house mark. Moreover, because Applicant applied for the mark in standard characters, we must consider all iterations including those that minimize VUSE or put each word on a different line, or maximize BEYOND to stand out by itself. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re Calphalon Corp.*, 122 USPQ2d 1153, 1160 (TTAB 2017); *cf. Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011). The argument that VUSE would be perceived separately and CHARGE BEYOND together is not persuasive.

In addition, the alternative meanings for CHARGE presented by Applicant make no sense in connection with these goods and services and the use of CHARGE with the word BEYOND. The usage examples in the dictionary for those meanings of CHARGE do not comport with the usage in Applicant’s mark:

- a. fill with feeling or quality, The atmosphere was charged with tension.<sup>11</sup>
- b. Informal A feeling of pleasant excitement; a thrill: got a real charge out of the movie.<sup>12</sup>
- c. To rush against in an attack: The troops charged the enemy line.; A rushing, forceful attack: repelled the charge of enemy troops; the charge of a heard of elephants.<sup>13</sup>

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<sup>11</sup> <https://www.ahdictionary.com>, App. Ser. No. 88822603, June 3, 2020 Office Action p. 14.

<sup>12</sup> *Id.* at p. 16.

<sup>13</sup> *Id.* at pp. 14, 15. We do not see the exact reference “quickly and forcefully” in the records.

We find that CHARGE is merely descriptive of a feature of the goods and services, namely that they require electrical charging to function. CHARGE BEYOND does not present a separate unitary commercial impression and the merely descriptive meaning of CHARGE is not removed in the context of this mark. The disclaimer requirement is appropriate.

## II. Likelihood of Confusion

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.”); see also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all [*DuPont*] factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods [and services].’”)

(quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Relatedness of the Goods and Services, Trade Channels and Classes of Consumers

When considering the goods and services, trade channels and classes of consumers, we must make our determinations based on the goods and services as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The issue is not whether the goods or services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods [or services] in question are different from, and thus not related to, one another in kind, the same goods [or services] can be related in the mind of the consuming public as to the origin of the goods [or services].”).

Turning first to Application Serial No. 88662587, Applicant’s identification includes identical services to Registrant’s services: retail store services for electronic cigarettes. Turning to Application Serial No. 88822603, Applicant’s identification of goods includes identical goods to Registrant’s goods: electronic cigarettes. It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods or services within a particular class

in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014). Further, here, where the goods and services are identical and there are no limitations as to channels of trade or classes of consumers, we presume that Applicant's and Registrant's goods and services will be offered via the same channels of trade to the same classes of consumers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

Applicant does not present argument on these factors.

The goods, services, channels of trade and classes of consumers are the same and these factors weigh heavily in favor of likely confusion.

#### B. Similarity/Dissimilarity of the Marks

We compare the marks in their entireties as to "appearance, sound, connotation and commercial impression." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). Moreover, when the goods or services are identical or virtually identical, as is the case here, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra Inc.*, 101 USPQ2d at 1908; *In*

*re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Applicant's mark VUSE CHARGE BEYOND encompasses the entirety of Registrant's mark BEYOND. Applicant argues the other wording in its mark serves to distinguish the marks. Again, Applicant asserts that VUSE is its house mark and combined with its placement at the beginning of the mark it is the more dominant part of its mark. Even accepting VUSE is a house mark, adding it to an otherwise confusingly similar mark does not obviate likely confusion. *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986) (holding applicant's mark, SPARKS BY SASSAFRAS (stylized), for clothing, and registrant's mark, SPARKS (stylized), for footwear, likely to cause confusion, noting that "[t]hose already familiar with registrant's use of its mark in connection with its goods, upon encountering applicant's mark on applicant's goods, could easily assume that 'sassafras' is some sort of house mark that may be used with only some of the 'SPARKS' goods").

Applicant also relies on its position that CHARGE BEYOND "serves as an inherently distinctive component in Applicant's Mark that is not present in the Cited Mark." App. Brief, 9 TTABVUE 18. Applicant concludes that "taken as a whole, Applicant's Mark connotes Applicant's inherently distinctive VUSE brand in conjunction with an inherently distinctive unitary phrase, 'charge beyond,' connoting the charge of emotion evoked in users as a part of their experience with Applicant's

Services and products, and further connoting Applicant's rapid innovation in technology, and the accompanying user." *Id.*

We agree with Applicant that VUSE is the more dominant portion as a coined term at the beginning of its mark. However, because the mark is presented in standard characters, we must also consider presentations that minimize the prominence of VUSE and accentuate the word BEYOND. *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 98 USPQ2d at 1258-59. This also impacts how we consider the remaining wording, and we do not agree that consumers would read VUSE separately and CHARGE BEYOND as a phrase. It is perhaps possible depending on the presentation in the marketplace, but a registration of a mark in standard characters is not limited to a particular display. The word BEYOND could be viewed separately as part of a string of three words, or be presented in larger font to draw the attention of the consumer. When the word is perceived on its own, it has the same connotation and commercial impression as Registrant's mark, but even if it is part of a phrase "CHARGE BEYOND" the meaning of "the charge of emotion evoked in users as a part of their experience with Applicant's Services and products," or "connoting Applicant's rapid innovation in technology, and the accompanying user," may also be attributed to Registrant's mark BEYOND when taken in the context of the goods and services. Applicant also points to various prior cases where the Board reversed likelihood of confusion refusals. However, each case presents its own facts and record, and must be decided on its own merits. *E.g.*, *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). *In re Davey Prods. Pty*, 92 USPQ2d 1198, 1206 (TTAB 2009); *In re Wilson*, 57 USPQ2d

1863, 1871 (TTAB 2001); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re Nat'l Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016).

In support of its argument that the “office has already determined that the Cited Mark can coexist with other marks that incorporate additional and different words with the word ‘beyond’ for use in connection with goods and services identical and related to registrant’s services,” (9 TTABVUE 18) Applicant submitted four third-party registrations owned by three different parties:<sup>14</sup>

Registration No.	Mark	Goods/Services
5834877	ABOVE AND BEYOND	Cigars; tobacco
2880936	PLEASURE BEYOND EXPECTATION	Cigars
6139081	HEMP & BEYOND	Retail store services featuring ... vape pens ...
5856760	ABOVE AND BEYOND BLANCO (and design)	Cigars

Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. *E.g.*, *In re i.am.symbolic, llc*, 123 USPQ2d at 1744; *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009). However,

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<sup>14</sup> February 24, 2021 Request for Reconsideration, TSDR pp. 37-44. The application for BEYOND TOBACCO for “smoker’s articles in the nature of hemp cigarettes” is only probative of the fact that the application was filed and does not support Applicant’s argument. *In re Team Jesus LLC*, 2020 USPQ2d 11489, at \*3 n. 29 (TTAB 2020).

a large number of active third-party registrations including the same or similar term or mark component for the same or similar goods or services may be given some weight to show, in the same way that dictionaries are used, that a mark or a portion of a mark has a normally understood descriptive or suggestive connotation, leading to the conclusion that the term or mark component is relatively weak. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017).

The potential relevance of third-party registrations and uses offered to support registrability over the cited registration depends on the relationship they bear to the application and registration at issue. The third-party marks must generally be as similar to the registered mark as the applied-for mark. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284-85 (Fed. Cir. 1984) (“Applicant introduced evidence of eight third-party registrations for tea which contain the word ‘SPICE’, five of which are shown to be in use. None of these marks has a ‘SPICE (place)’ format or conveys a commercial impression similar to that projected by the SPICE ISLANDS mark, and these third-party registrations are of significantly greater difference from SPICE VALLEY and SPICE ISLANDS than either of these two marks from each other.”); *see also In re Mighty Leaf Tea*, 94 USPQ2d at 1259. Potential relevance also depends on whether the third-party

registered marks and uses are for goods or services as similar to those in the cited registration as those identified in the application. *See, e.g., Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) (“None of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each other. Thus, we agree with the Board that nothing in the record shows a narrowing of Editors’ identification with A.C.E./ACE by third party marks with respect to the relevant public, namely, the film industry or even the broader entertainment industry. In sum, Cable’s argument that it can use ACE because ACE is a ‘weak’ mark, as an abstract proposition, is not only unpersuasive but essentially meaningless.”) (citation omitted); *see also Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694-95 (Fed. Cir. 2018) (citing *Nat’l Cable Tel. Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991)).

Three third-party registrations is a meager showing to establish room on the Register for Applicant’s mark. In addition, while we agree that cigar and tobacco goods are similar, they are not identical to Applicant’s goods and services, in contrast to Registrant’s goods. In addition, the marks ABOVE AND BEYOND and PLEASURE BEYOND EXPECTATION are clearly unitary phrases.

We bear in mind that the “marks ‘must be considered . . . in light of the fallibility of memory.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565

F.2d 683, 196 USPQ2d 1, 3 (CCPA 1977)). While a close side-by-side comparison of the marks could reveal the differences between them, that is not the proper way to determine likelihood of confusion, as that is not the way customers will view the marks in the marketplace. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *see also In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983) and cases cited therein; *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016). To customers in the marketplace, by incorporating the entirety of Registrant's mark, Applicant's mark is similar in appearance and sound, and the common element conveys a similar connotation and commercial impression. In terms of appearance, sound, connotation, and commercial impression, we find the similarity of the marks — considered in their entireties — outweighs their dissimilarities.

Combined with the identical nature of the goods and services, the presence of the entirety of Registrant's arbitrary mark in Applicant's standard character mark, is enough to create likely confusion. In view thereof, the similarity of these marks weighs in favor of a finding of likelihood of confusion.

### C. Conclusion

In sum, we hold that because the marks are similar, the goods and services are identical in part, and the trade channels and classes of consumers, at a minimum, overlap, confusion is likely between Applicant's VUSE CHARGE BEYOND and Registrant's BEYOND mark.

**Decision:** The refusal to register Applicant's mark under Trademark Act Section 2(d) is affirmed in each application; and the requirement to disclaim the word CHARGE is affirmed in each application.